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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,740	07/26/2005	Shin-ichi Kadowaki	2004_1498A	9921
513 7590 10/27/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
AGUSTIN, PETER VINCENT				
ART UNIT		PAPER NUMBER		
2627				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,740

Applicant(s)

KADOWAKI ET AL.

Examiner

Peter Vincent Agustin

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-50, 52, 53, 151 and 152 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-50, 52, 53, 151 and 152 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This application is a national stage entry (371) of PCT/JP03/04209 filed on April 2, 2003.
2. Claims 46-50, 52, 53, 151 & 152 are currently pending.

Drawings

3. Replacement drawings for Figures 20-27 were received on October 1, 2008. These drawings are acceptable.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 46-50, 52, 53, 151 & 152 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art.

In regard to claim 46, the admitted prior art discloses an optical storage medium (Figure 25) comprising multiple tracks (1301), the multiple tracks being formed from one of concentric tracks and spiral tracks (spiral, as shown), the multiple tracks being for recording information using marks and spaces arranged between the marks (see Figure 21), wherein each mark has a mark length limited by a run length limited (RLL) modulation (see page 3, lines 14-17).

Note that the limitation “wherein a playback signal detected by one of an edge of a mark and an edge of a space, not including one of a shortest mark and a shortest space, denotes a first playback signal quality”, although not an improper limitation, is merely a statement of intended

use which neither defines the structure nor limits the scope of the claimed optical storage medium. See MPEP § 2106 & 2111.04.

In regard to claim 47's limitation "wherein a playback signal detected by one of an edge of a mark and an edge of a space including one of the shortest mark and the shortest space denotes a second playback signal quality", see note above.

In regard to claim 48's limitation "wherein the first playback signal quality is higher than the second playback signal quality", see note above.

In regard to claim 49's limitation "wherein jitter is detected as playback signal quality", see note above.

In regard to claim 50's limitation "wherein leading-edge jitter and trailing-edge jitter are distinguished from each other", see note above.

In regard to claim 52, the admitted prior art discloses that the optical storage medium includes multiple recording layers (Figure 20, elements 40b & 40c). In regard to the limitation "wherein the first playback signal quality is set for at least one layer of the multiple recording layers", see note above.

In regard to claim 53's limitation "wherein a quality of a layer of the multiple recording layers that is farthest from an optical pickup head is highest", see note above.

In regard to claim 151, the admitted prior art discloses a reproducing method (performed by the recording and playback system of Figure 20) for reproducing an optical storage medium (40) comprising multiple tracks (see Figure 21), the multiple tracks being formed from one of concentric tracks and spiral tracks (see Figure 25), the multiple tracks being for recording information using marks and spaces arranged between the marks (see Figure 21), wherein each

mark has a mark length limited by run length limited (RLL) modulation (see page 3, lines 14-17), the reproducing method comprising emitting a light beam (Figure 20, element 70). Note that the limitation “wherein a playback signal detected by one of an edge of a mark and an edge of a space, not including one of a shortest mark and a shortest space, denotes a first playback signal quality”, although not an improper limitation, is merely a statement of intended use which neither defines the structure nor limits the scope of the claimed optical storage medium, and does not positively recite a step for the claimed reproducing method. See MPEP § 2106 & 2111.04. Furthermore, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In regard to claim 152, the admitted prior art discloses a recording method (performed by the recording and playback system of Figure 20) for recording information onto an optical storage medium (40) comprising multiple tracks (see Figure 21), the multiple tracks being formed from one of concentric tracks and spiral tracks (see Figure 25), the multiple tracks being for recording information using marks and spaces arranged between the marks (see Figure 21), wherein each mark has a mark length limited by run length limited (RLL) modulation (see page 3, lines 14-17), the recording method comprising forming the marks and the spaces located between the marks by emitting a light beam to the optical storage medium (see Figure 20, element 70 and Figure 21). Furthermore, regarding the limitation “wherein a playback signal

detected by one of an edge of a mark and an edge of a space, not including one of a shortest mark and a shortest space, denotes a first playback signal quality”, see note above.

Response to Arguments

6. Applicant's arguments filed on October 1, 2008 have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is (571) 272-7567. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter Vincent Agustin/
Primary Examiner, Art Unit 2627